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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,950	12/04/2003	Ramnath N. Iyer	EP-7596	7388

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EXAMINER	
LANG, AMY T	

ART UNIT	PAPER NUMBER
1714	

DATE MAILED: 07/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/727,950	IYER ET AL.	
	Examiner	Art Unit	
	Amy T. Lang	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-21 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-21 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 7-11-2005.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claim 13 discloses an amount of thiadiazole from about 0.95 wt% to about 10 wt%. However, this range is not disclosed in the specification. Claim 14 discloses an amount of thiadiazole form about 3 wt% to about 5 wt%. However, this range is also not disclosed in the specification.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-2 and 4-21 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 8 of U.S. Patent No. US 2005/0054542 A1 (Muchmore). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following explanation.

Claim 8 of Muchmore US '542 discloses an automatic transmission fluid comprised of a lubricating oil and sufficient weight percent of 2,5-dimercapto-1,3,4-thiadiazole (DMTD) and/or derivatives.

Applicants' attention is drawn to MPEP 804 where it is disclosed that "the specification can always be used as a dictionary to learn the meaning of a term in a patent claim." *In re Boylan*, 392 F.2d 1017, 157 USPQ 370 (CCPA 1968). Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent. (underlining added by examiner for emphasis) *In re Vogel*, 422 F.2d 438,164 USPQ 619,622 (CCPA 1970).

Consistent with the above underlined portion of the MPEP citation, attention is drawn to where US '542 discloses the base oil as a natural or synthetic oil ([0087]). The derivatives are further disclosed as 2-hydrocarbylithio-5-mercapto-1,3,4-thiadiazole, 2,5-bis-(hydrocarbyldithio)-1,3,4-thiadiazole, and products from combining an oil soluble dispersant with 2,5-dimercapto-1,3,4-thiadiazole DMTD [0088]). The thiadiazoles are present in amounts from 0.025 to 5 wt% of the lubricating composition ([0088]). The term "automatic transmission" is defined as encompassing continuously variable

transmissions, so that it would have been obvious for US '542 to use belt-, chain-, or toroidal-type CVTs. Also, the term automatic transmission inherently encompasses steel-on-steel friction. Furthermore, since the composition disclosed by US '542 is the same as is instantly claimed, the disclosed composition would also display the same steel-on-steel friction properties.

4. Claims 1-2 and 4-21 are directed to an invention not patentably distinct from claim 8 of commonly assigned US 2005/0054542 A1 (Muchmore). Specifically, although the copending claims are not identical, they are not patentably distinct for the reasons set forth in paragraph 3 above.

5. The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned US 6,783,746, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 2, 4-5, 7-14, and 16-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Ward (US 6,251,840 B1).

Ward discloses a lubricating composition for use as a transmission fluid, including a continuously variable transmission, which inherently encompasses steel-on-steel contact (column 1, lines 12-17). The base oil consists of natural and synthetic lubricating oils in an amount greater than 80 wt% (column 2, lines 30-33, 47-52). The composition further includes 2-hydrocarbyldithio-5-mercapto-1,3,4-thiadiazole, 2,5-bis-(hydrocarbyldithio)-1,3,4-thiadiazole, products from combining an oil soluble dispersant

with 2,5-dimercapto-1,3,4-thiadiazole, and mixtures thereof (column 4, lines 38-62). The disclosed thiadiazoles are present in the lubricating composition from 0.025 to 5 wt% (column 4, lines 38-39). Since Ward discloses the same lubricating composition as is instantly claimed, the disclosed composition would also display the same steel-on-steel friction properties.

Therefore, Ward '840 anticipates the cited present claims.

8. Claims 1and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Srinivasan (US 2002/0151441 A1).

Srinivasan discloses an automatic transmission fluid comprised of major amount of base oil ([0003], [0032]). The composition further includes monoalkyl and dialkyl thiadiazoles in amount from 0.00 to 0.05 wt% ([0133], [0134]). Therefore, the disclosed thiadiazole is substituted with a linear hydrocarbon group. Furthermore, since Srinivasan discloses the same composition as is instantly claimed, the disclosed composition would also display the same steel-on-steel friction properties.

Therefore, Srinivasan '441 anticipates the cited present claims.

9. Claims 1-2 and 4-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Muchmore (US 2005/0054542 A1).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome

either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

For explanation of the rejection, see paragraph 3 above.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 6 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ward (US 6,251,840 B1) in view of Ooyama (US 6,634,977 B2).

Ward, as disclosed in paragraph 7 is incorporated here by reference, discloses a continuously variable transmission fluid (hereinafter, "CVT"). However, Ward is silent as to the specific type of CVT.

Ooyama discloses continuously variable transmissions for vehicles, including belt-, chain-, and toroidal-type CVT's (column1, lines 16-38; column 4, line 55 through column 5, line 15). Therefore, it is common for a CVT to be of a belt-, chain-, and toroidal-type so that it would have been obvious for Ward to use any one of these. Therefore, one of ordinary skill would thereby obtain the invention as set forth in the presently cited claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tagliamonte (US 6,528,458) discloses a lubricant composition comprised of a base oil and 2,5-dimercapto-1,3,4-thiadiazole (DMTD) or derivatives.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy T. Lang whose telephone number is 571-272-9057. The examiner can normally be reached on M-F 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ATL
06/29/2006

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